REMARKS

Claims 28-63 were pending in the instant application. By this amendment, claims 33, 39, 45, 51, 57, and 63 have been amended and new claim 64 has been added to expedite allowance of the pending claims. No new matter is added by this amendment, which is fully supported by the specification and claims as originally filed, as discussed in more detail below. As such, claims 28-64 will be pending upon entry of the instant application.

1. THE REJECTIONS OF CLAIMS 33, 39, 45, 51, 57, AND 63 UNDER 35 U.S.C. § 112 FIRST PARAGRAPH SHOULD BE WITHDRAWN

Claims 33, 39, 45, 51, 57, and 63 are rejected under 35 U.S.C. § 112, first paragraph, for lack of written description support and lack of enablement for the use of derivatives of erythropoietin in the claimed methods. In response, claims 33, 39, 45, 51, 57, and 63 have been amended to delete the phrase "and derivatives thereof." As amended, the claims recite methods for treating cerebral ischemia comprising peripherally administering native erythropoietin, recombinant human erythropoietin or animal erythropoietin, which, according to the Examiner, are enabled and supported by the specification.

As such, Applicants respectfully submit that all rejections of claims 33, 39, 45, 51, 57, and 63 under 35 U.S.C. § 112 first paragraph have been overcome and should be withdrawn.

2. NEW CLAIM 64 SATISFIES THE WRITTEN DESCRIPTION AND ENABLEMENT REQUIREMENTS OF 35 U.S.C. § 112 FIRST PARAGRAPH

New claim 64 has been added to encompass the subject matter deleted from claims 33, 39, 45, 51, 57, and 63, *i.e.*, the use of erythropoietin derivatives in methods for treating cerebral ischemia. Because the subject matter of claim 64 corresponds to the subject matter that was rejected in the Office Action under 35 U.S.C. § 112, first paragraph, for lack of written description and enablement, applicants address hereinbelow these rejections, and the Examiner's comments related thereto, in connection with new claim 64. Applicants believe that the rejections are in error for the reasons set forth below.

A. EPO Derivatives Are Described in the Specification

According to the Examiner, the specification provides adequate written description for native erythropoietin, recombinant human erythropoietin or animal erythropoietin but not

derivatives thereof. The Examiner contends that the specification does not describe EPO derivatives that are effective to exert a neuroprotective effect upon peripheral administration and does not provide any assay to evaluate the function of any modified polypeptide.

First, applicants point out that erythropoietin derivatives were well known to the skilled artisan at the time of the filing of the instant application, and no undue experimentation is necessary to make and use such EPO derivatives in the methods disclosed in the instant application. Such EPO derivatives are explicitly described in the application as peptides that bind the EPO receptor, molecules with increased or altered EPO receptor affinity, muteins comprising molecules with more or fewer numbers of glycosylation sites. See page 9, line 34, to page 10, line 13. The specification provides actual examples of EPO derivatives that can be used in the claimed methods, and incorporates by reference issued U.S. patents containing numerous well known EPO derivatives, and methods for making such derivatives, that can be used in the claimed methods. For example, at page 10, lines 14 to 25, the specification states:

> By way of non-limiting example, forms of EPO useful for the practice of the present invention include EPO muteins, such as those with altered amino acids at the carboxy terminus described in U.S. Patent 5,457,089 and in U.S. Patent 4,835,260; EPO isoforms with various numbers of sialic acid residues per molecule, such as described in U.S. Patent 5,856,292; polypeptides described in U.S. Patent 4,703,008; agonists described in U.S. Patent 5,767,078; peptides which bind to the EPO receptor as described in U.S. Patents 5,773,569 and 5,830,851; small-molecule mimetics which activate the EPO receptor, as described in U.S. Patent 5,835,382; and EPO analogs described in WO 9505465, WO 9718318, and WO 9818926. All of the aforementioned citations are incorporated herein to the extent that such disclosures refer to the various alternate forms or processes for preparing such forms of the erythropoietins of the present invention.

Thus, the specification provides a sufficient number of structures of erythropoietin derivatives that can be used in connection with the methods of the instant invention. Applicants submit that the claimed methods for using EPO derivatives to treat cerebral ischemia are sufficiently described in the instant application to convey to the skilled artisan that the inventor had possession of the claimed subject matter. Considering the high level of skill in the art, the relevant physical, chemical and functional characteristics of the use of such compositions provided by the specification fully satisfy the written description requirement of Section 112.

The test for sufficiency of written description is whether the disclosure of the application 'reasonably conveys to the artisan that the inventor had possession' of the

claimed subject matter. *In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. (BNA) 1089, 1096 (Fed. Cir. 1983); accord *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563; *see also, Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 U.S.P.Q. (BNA) 177, 179 (Fed. Cir. 1985). The criteria for determining sufficiency of written description set forth in Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112 ¶ 1, "Written Description Requirement" ("the Guidelines") (published in the January 5, 2001 Federal Register at Volume 66, Number 4, p. 1099-1111), specifies that:

> The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice (see (1)(a) above), reduction to drawings (see (1) (b) above), or by disclosure of relevant, identifying characteristics, *i.e.*, structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus (see (1)(c), above).
> *Id.* at p. 1106, column 3, *l.* 13-29.

Furthermore, in accordance with the Guidelines, what is conventional or well known to one of skill in the art need not be disclosed in detail, and, where the level of knowledge and skill in the art is high, a written description question should not be raised. The Guidelines specify that:

> Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient. Patents and printed publications in the art should be relied upon to determine whether an art is mature and what the level of knowledge and skill is in the art. In most technologies which are mature, and wherein the knowledge and level of skill in the art is high, a written description question should not be raised for original claims even if the specification discloses only a method of making the invention and the function of the invention.
> *Id.* at p. 1106, column 2, *ll.* 50-59.

Thus, where the specification discloses a representative number of species and/or relevant identifying characteristics, *i.e.*, physical, chemical and/or functional characteristics sufficient to allow a skilled artisan to recognize the applicant was in possession of the claimed invention, a rejection for lack of written description under Section 112, first paragraph, is misplaced, particularly in this case where the technology is mature and the level of skill in the art is high and the specification discloses at a minimum the function of the invention and a method for making the invention.

In the instant case, the specification discloses a sufficient number of representative number of species and relevant identifying characteristics, including physical, chemical and/or functional characteristics sufficient to allow a skilled artisan to recognize the applicant was in possession of the claimed invention. See page 9, line 34, to page 10, line 25.

The Examiner also cites *Fiddes v. Baird*, stating that claims directed to mammalian FGFs were found to be unpatentable due to lack of written description because the specification provided only the bovine sequence. However, the facts of this case are readily distinguished from the facts of *Fiddes*. In *Fiddes,* the patentee attempted to claim all mammalian FGFs with only the disclosure of one sequence, a bovine sequence, to support this generic claim. There were no known mammalian FGFs known at the time, and the disclosure of the application provided no structure or sequence of a mammalian FGF. Here, the situation is quite different. The present claims do not encompass *any* erythropoietin derivative, but, rather, encompass only those erythropoietin derivatives that have the specific characteristic of being capable of exerting a neuroprotective effect. The sequences and structures of dozens of analogs, muteins and derivatives useful for practicing the invention, and methods for preparing such derivatives were actually known at the time, and are part of the specification.

Thus, considering the large number of derivatives of erythropoietin disclosed in the specification, the identification of the chemical and functional characteristics necessary for identifying erythropoietin derivatives useful in the claimed methods, and the high level of skill in the art, applicants believe the rejection of the use of derivatives of erythropoietin under Section 112, first paragraph, is in error and request its withdrawal.

B. <u>The Specification Enables The Use of EPO Derivatives</u>

The method of new claim 64 treating cerebral ischemia using erythropoietin derivatives is also fully enabled by the specification as originally filed. However, the Examiner asserts that that the specification is not enabling for a method for treating cerebral ischemia comprising peripherally administering derivatives of erythropoietin molecules because the scope of patent protection for claims reciting EPO derivatives does not bear a reasonable correlation with the scope of enabling disclosure set forth in the specification. The Examiner contends that derivatives can broadly encompass any type of mutein, variant, fragments, chemical modifications, analogs, *etc.*, and the specification does not teach how to make and use such EPO derivatives, and that the specification does not provide any assay to evaluate their function.

Applicants submit that the claimed derivatives of erythropoietin methods are fully enabled by the teachings of the specification as it would be understood and applied by one skilled in the art. The specification discloses explicit examples of specific muteins, variants, fragments, chemical modifications, and analogs, as well as specific assays for evaluating their function as neuroprotective EPO derivatives effective for treating cerebral ischemia. For example, the specification discloses explicit examples of specific derivatives that can be used in methods for treating cerebral ischemia (specification at page 10, lines 15 to 25). Specific formulations and non-toxic dosages of erythropoietin derivatives that may be used to achieve neuroprotection are also described (specification at page 22, line 25 to page 24, line 6; see also page 4, lines 26-27). Methods for making and testing such derivatives were known in the art and well within the purview of the skilled artisan. The specification further provides a model system that can be used to test specific EPO derivatives for their ability to provide a neuroprotective effect for treating cerebral ischemia (page 32, line 25 to page 33, line 23). Moreover, the specification provides a working example in which the activity of an EPO derivative is tested for its neuroprotective activity as compared to the neuroprotective activity of recombinant erythropoietin (page 32, line 25 to page 33, line 23 and Figs. 4A-B). Thus, using the teachings of the instant application, the skilled person may routinely make and use erythropoietin derivatives for practicing the claimed methods for treating cerebral ischemia without undue experimentation.

In view of the foregoing, applicants submit that the rejection for lack of enablement under 35 U.S.C. § 112, first paragraph, is in error and should be withdrawn.

3. THE REJECTION UNDER 35 U.S.C. § 112 FIRST PARAGRAPH FOR WRITTEN DESCRIPTION, NEW MATTER, SHOULD BE WITHDRAWN

Claims 40 and 46 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The Examiner contends that the specification as originally filed does not provide support for "without a toxic increase in hemoglobin concentration or hematocrit" because "the exact wording or connotation of the instant claims is not readily apparent" from the written description of the specification.

It is well established that the law does not require that the specification provide support in exactly the same words as used in the claims to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. It is enough that the description conveys to

one skilled in the art that the applicant had possession of the invention. For example, see *In re Wilder*, 736 F.2d 1516, 1520, 222 U.S.P.Q. 369, 372 (Fed. Cir. 1984):

> It is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant has invented the subject matter later claimed.

See also *Application of Lukach*, 442 F.2d 967, 969, 169 U.S.P.Q. 795, 796 (C.C.P.A. 1971): "[T]he invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112."

In this case, the specification provides sufficient written description support for the use of an amount of erythropoietin effective to exert a neuroprotective effect without a toxic increase in hemoglobin concentration or hematocrit. The specification states that one embodiment of erythropoietin is nonerythropoietic, defined as "capable of exerting the activities described herein but not causing an increase in hemoglobin concentration or hematocrit" (page 23, lines 11 to 13). Indeed, explicit disclosure of the use of an amount of erythropoietin effective to exert a neuroprotective effect "without a toxic increase in hemoglobin concentration or hematocrit" is provided in the section entitled "Methods For Protecting Excitable Tissue From Injury":

> In another embodiment, the present invention is directed toward a method for protecting a mammal from pathology resulting from injury to excitable tissue. Protection is provided by administering to a mammal by a peripheral route of administration an amount of erythropoietin effective to protect the excitable tissue from injury. As is shown in detail in the example in Section 8, below, EPO administered in advance of the toxin kainate is markedly neuroprotective in mice, raising seizure threshold and preventing death. The neuroprotective effect EPO is large and is sustained. *It is notable that the positive effects seen herein occur within too short of a time relative to the administration of an EPO to be a result of an increase in hematocrit as a consequence of the erythropoietic activity of EPO. Furthermore, as noted above, an embodiment of the present invention comprises an EPO* which *lacks the ability to increase hematocrit.* (Emphasis added.)
> (Specification at page 13, lines 17 through 29, and the working example in Section 8, page 31, line 13 to page 32, line 22)

In this section, the specification makes clear that the dosage regimen of EPO is an amount sufficient to achieve a neuroprotective effect without a toxic increase in hematocrit as a consequence of the erythropoietic activity of EPO.

Moreover, the specification makes abundantly clear that the dosages of EPO used for modulation and protection of excitable tissue be *non-toxic* dosages of EPO. For example, all

dosages prescribed are explicitly provided to be "effective non-toxic dosages of EPO" (page 4, lines 26 to 35, and again at page 23, lines 17 to 27). The specification enumerates the factors that should be considered to determine appropriate *non-toxic* dosage of erythropoietin, and specifies that the skilled practitioner is readily be able to make such a determination according to standard clinical techniques. For example, the specification states:

> Selection of the preferred effective dose will be determined by a skilled artisan based upon considering several factors which will be known to one of ordinary skill in the art. Such factors include the particular form of erythropoietin, and its pharmacokinetic parameters such as bioavailability, metabolism, half-life, etc., which will have been established during the usual development procedures typically employed in obtaining regulatory approval for a pharmaceutical compound further factors in considering the dose include the condition or disease to be treated or the benefit to be achieved in a normal individual, the body mass of the patient, the route of administration, whether administration is acute or chronic, concomitant medications, and other factors well known to affect the efficacy of administered pharmaceutical agents. Thus the precise dosage should be decided according to the judgment of the practitioner and each patient's circumstances, e.g., depending upon the condition and the immune status of the individual patient, according to standard clinical techniques.
> (Specification at page 22, line 32 to page 23, line 9)

As an indication of the level of skill in the art at the time of the invention, the Examiner's attention is invited to the 2000 edition of the Physicians' Desk Reference ("PDR"), the art-accepted standard reference manual for practitioners at the relevant time; and, in particular, the section of the PDR relating to erythropoietin (see PDR, pp. 519-525 and 2125-2131, a copy of which is on record as Exhibit C of the Response filed December 18, 2002). The PDR shows that, depending on the patient population being treated with erythropoietin, different hematocrit ranges are targeted to avoid toxicity.[1] The PDR shows that practitioners monitor the patient's hematocrit during therapy with erythropoietin and, to avoid toxicity, adjust the dose and/or withhold treatment if the patient's hematocrit approaches or exceeds the upper limits of a target range.

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[1] For example, in patients with chronic renal failure, the PDR recommends dosing erythropoietin to achieve *non-toxic* target hematocrits ranging from 30% to 36% (*e.g.*, see PDR, p. 523, col. 1, *ll.* 17-96 and p. 2129, col. 1, *ll.* 8-93, and accompanying table in cols. 2 and 3). The PDR notes that toxicity in the form of polycythemia (a condition marked by an abnormal increase in the number of circulating red blood cells) can be avoided by carefully monitoring the hematocrit and adjusting doses of EPO, withholding erythropoietin if the hematocrit approaches the high-end of the target range (36% for this patient population) or increases by more than 4 points in any 2-week period, until the hematocrit returns to the suggested target range (30% to 36% for this patient population; see PDR, p. 523, col. 1, and p. 2129, col. 1, under "Dose Adjustment"). In contrast, for cancer patients on chemotherapy, the PDR teaches to adjust the dosage at a different hematocrit level, *i.e.*, if the hematocrit exceeds 40% (see p. 2129, col. 2, under "Dose Adjustment").

Given the disclosure in the sections of the specification recited above, it is clear that the skilled person would recognize that the applicant had possession of the claimed invention of a method for administering to a mammal or human subject an amount of erythropoietin effective to exert a neuroprotective effect without a toxic increase in hemoglobin concentration or hematocrit.

In view of the foregoing, applicants submit that the new matter rejection of claims 40 and 46 under 35 U.S.C. § 112, first paragraph, is in error and should be withdrawn.

4. THE REJECTIONS UNDER 35 U.S.C. § 112 SECOND PARAGRAPH FOR INDEFITENESS SHOULD BE WITHDRAWN

Claims 28, 34, 40, 46, 52, and 58 are rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The Examiner contends that the claims are indefinite because the claims do not have a step that clearly relates back to the preamble.

Applicants respectfully submit that the step of "administering to said mammal" of claims 28, 40, and 52, and the step of "administering to said human subject" of claims 34, 46, and 58 claims clearly relate back to their respective preambles for antecedent basis, thereby requiring that the mammal or human subject, respectively, be in need of treatment of cerebral ischemia. In addition, to further clarify that the goal of the preamble is achieved, claims 28, 34, 40, 46, 52, and 58 have been amended to require that erythropoietin is administered to a mammalian or human subject in need of treatment of cerebral ischemia.

The Examiner further contends that claims 40, 46, 52, and 58 are indefinite because neither the specification nor the art provides an unambiguous definition for the terms "*without a toxic increase* in hemoglobin concentration or *hematocrit*" or "*without an increase in hematocrit*", such that a difference in scope between these two claims can be ascertained.

Applicants submit that both the phrase "*without an increase in hematocrit*" and the phrase "*without a toxic increase* in hemoglobin concentration or *hematocrit*" are clear and unambiguous. A person skilled in the art at the time of the invention would know that the phrase "*without an increase in hematocrit*" in claims 52 and 58 means that the amount of erythropoietin administered to a subject is effective to exert a neuroprotective effect without a statistically significant rise in the hematocrit level of the subject. The skilled practitioner would know to monitor a patient's hematocrit during treatment to avoid any statistically significant increase in his or her hematocrit levels.

Likewise, the phrase "*without a toxic increase* in hemoglobin concentration or *hematocrit*" in claims 40 and 46 is clear and unambiguous, requiring that the amount of

erythropoietin administered is effective to exert a neuroprotective effect without an increase in hemoglobin concentration or hematocrit that would be toxic to the subject. As noted in Section 3 and footnote 1 above, the skilled practitioner would know how to control the hematocrit in any particular patient to avoid toxicity. This dosage may vary from subject to subject, depending on the condition of the patient and the surrounding circumstances. Such variation does not render the dosage unclear or ambiguous. Depending on the patient population being treated with erythropoietin, different hematocrit ranges may be readily targeted to avoid toxicity. The PDR shows that practitioners monitor the patient's hematocrit during therapy with erythropoietin and, to avoid toxicity, adjust the dose and/or withhold treatment if the patient's hematocrit approaches or exceeds the upper limits of a target range. For example, as noted in footnote 1 above, in patients with chronic renal failure, the PDR recommends dosing erythropoietin to achieve *non-toxic* target hematocrits ranging from 30% to 36% (*e.g.*, see PDR, p. 523, col. 1, *ll.* 17-96 and p. 2129, col. 1, *ll.* 8-93, and accompanying table in cols. 2 and 3).

Finally, regarding the Examiner's concern that the difference in scope between an "increase" and a "toxic increase" of hematocrit cannot be ascertained from the art or from the specification, applicants respectfully submit that the difference in scope between claims is not legally relevant to the question of claim definiteness. The Federal Circuit has long recognized that the doctrine of claim differentiation is not absolute, and just because different words are used does not automatically require that the claims must be construed to be different in scope. *Tandon Corp. v. U.S. Int'l Trade Comm'n*, 831 F.2d 1017 (Fed. Cir. 1987). The *Tandon* Court stated, "At the same time, practice has long recognized that 'claims may be multiplied. . . to define the metes and bounds of the invention in a variety of different ways' (citations omitted). Thus, two claims which read differently can cover the same subject matter. Further, as this court stated in D.M.I., (citations omitted), 'claims are always interpretable in light of the specification that led to the patent." *Tandon,* 831 F.2d at 1023. Thus, as long as a claim is clear and unambiguous and its scope can be understood to the skilled artisan, the difference in scope between it and other claims in a patent is not legally relevant to the question of claim definiteness.

Therefore, based on the disclosure provided by the specification and the knowledge of the skilled person in the art, the claim terms "*without an increase in hematocrit*" and "*without a toxic increase* in hemoglobin concentration or *hematocrit*" are clear and unambiguous. As such, applicants submit that the rejection for indefiniteness under 35 U.S.C. § 112, second paragraph, has been overcome and request its withdrawal.

5. THE REJECTIONS UNDER 35 U.S.C. § 102(b) FOR LACK OF NOVELTY SHOULD BE WITHDRAWN

Claims 28-63 are rejected under 35 U.S.C. § 102(b) as anticipated by Igari *et al.*, US Patent 5,591,713. The Examiner contends that the dose taught by Igari inherently has a neuroprotective effect and is non-toxic, and that "treating cerebral ischemia" and "for the treatment of stroke" are intended uses recited in the instant claims and are not given patentable weight, citing *Bristol Myers Squibb Company v. Ben Venue Laboratories*, 58 USPQ 1508 (CAFC 2001) for the proposition that the preamble language recites an intended use or purpose and as such is non-limiting. The Examiner specifically asserts that the instant claims "do not identify a specific mammalian patient population (claims do not state that the mammal suffers from any condition)." Applicants disagree with the Examiner's reasoning, as set forth below.

The general rule is that if the preamble is not necessary to give "life meaning and vitality to the claim, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation." *Altiris, Inc. v. Symatec Corp,*. 318 F.3d 1363, 1371 (Fed Cir. 2003), citing *Catalina Mktg.*, 289 F.3d at 808. However, if there is clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art, *or when limitations in the body of the claim rely upon and derive antecedent basis from the preamble*, the preamble is considered to be a limitation necessary to give "life meaning and vitality to the claim." *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003), *see also C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1350 (Fed. Cir. 1998) ("[A] preamble usually does not limit the scope of the claim unless the preamble provides antecedents for ensuing claim terms and limits the claim accordingly").

In the instant case, the preamble is clearly a claim limitation because the bodies of independent claims 28, 34, 40, 46, 52, and 58 relate back to their respective preambles for antecedent basis. In each case, the preamble provides the appropriate context for the terms "said mammal" or "said human subject", requiring that the mammal or human subject referred to in the body of the claim is one which is in need of treatment of cerebral ischemia. Moreover, claims 28, 34, 40, 46, 52, and 58 have been further amended to add the language "in need thereof" to explicitly clarify that erythropoietin is administered to a particular patient population, *i.e.*, a patient in need of treatment of cerebral ischemia.

Applicants submit that Igari does not anticipate the claimed invention. At best, Igari teaches the use of water-soluble compositions of erythropoietin and hyaluronic acid as

sustained-release preparations for treatment of known erythropoietin indications. However Igari does not disclose or suggest the use of erythropoietin for treating a mammal or a human subject in need of treatment of cerebral ischemia. Neither does Igari provide any working examples of the use of erythropoietin to treat a mammal or a human subject in need of treatment of cerebral ischemia. Thus, Igari does not disclose or suggest the claimed method for the use of erythropoietin for a patient population that is in need of treatment of cerebral ischemia by administering erythropoietin in an amount effective to exert a neuroprotective effect.

The Examiner's reliance on *Bristol-Myers* is inapposite. *Bristol-Myers* involved two patents related to a method of administering the anti-tumor drug paclitaxel (Taxol) to a cancer patient. The issue in that case concerned whether the results recited in the respective preambles (*i.e.*, of reduced hematologic toxicity and to effect tumor regression, respectively) need to be achieved for the prior art reference to be anticipatory.[2] There was no question, even in that case, that "said patient" recited in the claims must be the cancer patient undergoing Taxol treatment, as recited in the preamble.

Finally, the Examiner's statement that "Igari's teachings of administering erythropoietin do not teach against the intended use cited in the claims" is similarly inappropriate. Anticipation requires that the prior art disclose or suggest each of the elements of the claimed invention. Failure to teach against the claimed invention is insufficient basis for a rejection under 35 U.S.C. § 102(b).

Thus, for all the reasons discussed above, applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) for anticipation by Igari et al., US Patent 5,591,713 is in error and request its withdrawal.

6. CLAIM OBJECTIONS

The Examiner objects to claims 40, 46, 52, and 58 because the claims 40/52 and 46/58 appear to read on the same scope. This objection has been fully addressed in Section 4

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[2] The claims at issue in *Bristol-Myers* read "A method for reducing hematologic toxicity in a cancer patient undergoing Taxol treatment comprising parenterally administering to said patient an entineoplastically effective amount of about 135-175 mg/m2 taxol over a period of about three hours" and "A method for treating a cancer patient to effect regression of a taxol-sensitive tumor, said method being associated with reduced hematologic toxicity, said method comprising: (i) premedicating said patient with a medicament that reduces or eliminates hypersensitivity reactions; and (ii) parenterally administering to said patient an entineoplastically effective amount of about 135-175 mg/m2 taxol over a period of about three hours."

above. Thus, applicants respectfully request the withdrawal of the objection to claims 40, 46, 52, and 58.

CONCLUSION

Entry of the foregoing remarks and amendment into the record of the above-identified application is respectfully requested. Applicants estimate that the remarks and amendment made herein now place the pending claims in condition for allowance. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Please charge any required fee to Jones Day Deposit Account No. 50-3013. A duplicate of this sheet is enclosed for accounting purposes.

Respectfully submitted,

Date: December 6, 2005

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